

## REMARKS

In reply to the Office Action dated October 16, 2007, Applicant has cancelled claims 1, 48-50, 53, and 59, without prejudice or disclaimer of the subject matter therein, and amended claims 2, 26, 30, 51, and 54 to clarify the claimed invention. Claim 61 has been placed into independent form by incorporating the limitations of parent claim 54. New dependent claim 62 has been added to define the manner in which purchase information is received. As a result of this Amendment, claims 2-47, 51-52, 54-58, and 60-62 are currently pending.

### *Citation of Reference*

As noted subsequently, the Examiner has applied a reference to Brandstetter (U.S. Publication No. 200310036427) in rejecting the claims. The reference is not listed on the USPTO 892 form that accompanies the Office Action. Applicants respectfully request the Examiner to list the reference in a future USPTO 892 form so that it appears on the face of the patent when granted.

### *Allowable Claims*

As an initial matter, Applicant notes that the outstanding Office Action does not include any grounds for rejecting elected claims 6, 23, 58, and 61 on the basis of prior art. As a result, Applicant respectfully requests that the Examiner acknowledge that these claims contain allowable subject matter in either a non-Final Office Action, or a Notice of Allowability.

### *Claim Rejections - 35 U.S.C. § 112*

On page 2 of the Office Action, the Examiner rejected dependent claim 23 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not allegedly described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention. Specifically, the Examiner alleges that the "original disclosure fails to discuss the relationship of credit card and the present invention" and contends that the phrase "wherein the dimensions of said prepaid wagering card are substantially equivalent to the dimensions of a credit card," as recited in claim 23, is new matter.

Applicant respectfully disagrees. The original disclosure provides ample support for this subject matter. For instance, Fig. 1 illustrates how the dimensions of a prepaid wagering card

may be substantially equivalent to the dimensions of a credit card. It bears emphasizing, however, that the illustrative embodiments disclosed in the specification should not be used to limit the literal or equivalent scope of the actual claim feature. And, contrary to the Examiner's suggestion, original claim 23 is itself part of the original disclosure of the claimed invention. Moreover, based on the originally filed disclosure, one skilled in the art would readily recognize that the specification reasonably conveys how the dimensions of a prepaid wagering card may be substantially equivalent to the dimensions of a credit card. As a result, the specification fully complies with the requirements 35 U.S.C. § 112, first paragraph.

***Claim Rejections - 35 U.S.C. § 103***

As discussed on pages 2-6 of the Office Action, the Examiner rejected claims 2, 4, 5, 7-9, 11-13, 18-22, 24-29, 38-46, 51, 52, 54, 55, and 60 under 35 U.S.C. § 103(a) as being unpatentable over Nulph (U.S. Patent No. 6,203,011) in view of Stoken (U.S. Patent No. 5,657,899), and further in view of Katz (U.S. Publication No. 2003/0060261).

The Examiner also rejected claims 10 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Nulph in view of Katz for the reasons stated on pages 6-7 of the Office Action. The Examiner further rejected claims 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Nulph, in view of Brandstetter (U.S. Publication No. 200310036427), for the reasons set forth on page 7 of the Office Action.

The Examiner still further rejected claims 30-33, 36, 37, 47-50, 56, 57, and 59 under 35 U.S.C. § 103(a) as being unpatentable over Nulph in view of Protheroe (U.S. Patent No. 5,216,595, as discussed on pages 7-9 of the Office Action.

Finally, the Examiner rejected claims 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Nulph in view of Roberts (U.S. Patent No. 5,772,510), according to the rationale set forth on page 9 of the Office Action.

The applied references, however, fail to render the claimed invention unpatentable. Each of the rejected claims recites specific combinations of features that distinguish the invention from the prior art in different ways.

**Claim 2**

For example, independent claim 2, as presently amended, recites a combination that includes, among other things:

*wherein the prepaid wagering card is arranged to display the activation information, while concealing the' redemption information, when the prepaid wager card is purchased so as to prevent the redemption information from being used to electronically redeem said prepaid wager card for a prize before the prepaid wagered card has been activated and after the one or more wagering entries identify a winning entry included in the prepaid wagering card,*

**Claim 26**

Independent claim 26, as presently amended, recites another combination that includes, for example:

*providing a prepaid wagering card processing system configured to register the identification information of the prepaid wagering card when the prepaid wagering card is purchased at a point of sale terminal, activate the prepaid wagering card when the prepaid wagering card processing system electronically receives the activation information of the prepaid wagering card, and authorize redemption of the prepaid wagering card when the prepaid wagering card processing system electronically receives the redemption information; and*

*wherein the point of sale terminal comprises a non-traditional lottery terminal configured to facilitate a sale of a non-lottery product without a communication interface with a traditional lottery terminal, ...*

**Claim 30**

Independent claim 30, as presently amended, recites yet another combination that includes, *inter alia*,

*providing a prepaid wagering card processing system configured to register the identification information of the prepaid wagering card when the prepaid wagering card is purchased at a traditional lottery retailer having a dedicated lottery sales terminal or at a non-traditional lottery retailer having a general sales terminal, activate the prepaid wagering card when the prepaid wagering card processing system electronically receives the activation information of the prepaid wagering card, and authorize redemption of the prepaid wagering card when the prepaid wagering card processing system electronically receives the redemption information, the non-traditional lottery retailer configured to facilitate a sale of a non-lottery product without a communication interface with the traditional lottery retailer, ..*

**Claim 51**

Independent claim 51, as presently amended, recites a combination of that includes, for instance,

*providing a prepaid wagering card system configured to register the prepaid wagering card when the prepaid wagering card is purchased at a traditional lottery retailer having a dedicated lottery sales terminal or at a non-traditional lottery retailer having a general sales terminal, the nontraditional lottery retailer configured to facilitate a sale of a non-lottery product without a communication interface with the traditional lottery retailer, ....*

**Claim 54**

Finally, independent claim 54, as presently amended, recites a combination of that includes, for instance,

*wherein after the prepaid wagering medium is purchased, the data processor captures purchase information on the prepaid wagering medium by polling a point of sale terminal of a seller of the prepaid wagering medium, the point of sale terminal configured to facilitate a sale of a nonlottery product without a communication interface with the traditional lottery retailer, ...*

**The Cited Prior Art Is Deficient**

At the very least, Nulph, Stoken, Katz, Brandstetter, Protheroe, and Roberts fail to disclose or suggest any of these exemplary features recited in independent claims 2, 26, 30, 51, and 54.

To make out a prima facie case of obviousness, the Examiner must demonstrate (1) that Nulph, as proposed to be repeatedly modified by the teachings of Stoken, Katz, Brandstetter, Protheroe, and Roberts, disclose or suggest each and every feature recited in independent claims 2, 26, 30, 51, and 54, (2) that there is a reasonable probability of success of such modifications, and (3) the existence of an apparent reasons, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to make such modification so as to result in the claimed invention. See, e.g., M.P.E.P. § 2143, It bears emphasizing that teach of these requirements must be found in the prior art - not based on Applicant's own disclosure. See id.

Viewed against this backdrop, each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record. See in re Lee, 61 U.S.P.Q.2d 1430., 14.32 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." Id. To satisfy this burden, the Examiner must

specifically identify where support is found within the prior art to meet the requirements of 3.5 U.S.C. §§ 102(b) and 103. In this case., however, the Examiner has failed to satisfy his burden of demonstrating how Nulph, taken alone or in combination with of Stoken, Katz, Brandstetter Protheroe, and/or Roberts, can render obvious each and every one of the limitations present in independent claims 2, 26, 30, 51, and 54, as required by the manual of Patent Examining Procedure ("MPEP") and Federal Circuit jurisprudence.

#### Nulph

Nulph, which is the primary reference relied upon by the Examiner for all of the foregoing rejections, discloses a system for administering an interactive transaction in a lottery game.. (See Abstract) Nulph, however, fails to provide any disclosure of a prepaid wagering card that is arranged to display activation information, while concealing redemption information, when the prepaid wager card is purchased so as to prevent the redemption information from being used to electronically redeem said prepaid wager card for a prize before the prepaid wagered card has been activated and after the one or more wagering entries identify a winning entry included in the prepaid wagering card, as stated in independent claim 2. Nor does Nulph disclose or suggest a prepaid wagering card processing system that, for instance:

“registers identification information of the prepaid wagering card when the prepaid wagering card is purchased either at a point of sale terminal, or at a non-traditional lottery retailer having a general sales terminal,” as recited more particularly in independent claims 26, 30, and 51; or

“activates the prepaid wagering card when the prepaid wagering card processing system electronically receives the activation information of the prepaid wagering card, as recited more particularly in independent claims 26 and 30; or authorizes redemption of the prepaid wagering card when the prepaid wagering card processing system electronically receives the redemption information,” as recited more particularly in independent claims 26 and 30.

Nulph further fails to disclose or suggest a prepaid wagering card that is configured to facilitate a sale of a non-lottery product without a communication interface with the traditional lottery retailer, as recited in independent claims 30 and 51.

In addition, Nulph fails to disclose or suggest a prepaid wagering system that includes data process that captures purchase information on the prepaid wagering medium by polling a point of sale terminal of a seller of the prepaid wagering medium, the point of sale terminal configured to facilitate a sale of a non-lottery product without a communication interface with the traditional lottery retailer, as recited more particularly in independent claim 54.

Accordingly, Nulph, cannot render the claimed invention unpatentable under 35 USC. § 103(a).

Stoken, Katz, Brandstetter, Protheroe, and Roberts

Moreover, Applicants respectfully submit that Stoken, Katz, Brandstetter, Protheroe, and Roberts all fail to remedy the deficiencies of Nulph. For example, the Examiner relies upon Stoken solely to allegedly disclose the existence of a "wagering card, wherein the card has a front and back view," as stated on page 3 of the Office Action. The Examiner also relies upon Katz to ostensibly disclose the existence of a "wagering card game where certain information is encrypted," as stated on page 4 of the Office Action. And the Examiner relies upon Brandstetter to purportedly disclose the use of a "wagering game that teaches that a user is able to put his/her contact information on the wagering card," as stated on page 7 of the Office Action. Similarly, the Examiner relies upon Protheroe to allegedly teach "a method of activating a wagering card that is capable of determining what kind of retailer the card is being activated," as stated on page 8 of the Office Action. Finally, the Examiner relies upon Roberts to allegedly disclose "a wagering card game wherein the wagering card includes the date and time information at where the wagering card was sold," as stated on page 9 of the Office Action.

Modifying the Nulph system with the teachings of ,Stoken, Katz, Brandstatter, Protheroe, and Roberts, would thus fail to overcome the shortcomings of Mulch.

For at least these reasons, Nulph, Stoken, Katz, ;Brandstatter, Protheroe, and Roberts fail to disclose or render obvious each and every element recited in independent claims 2, 26, 30, 51, and 54.

In addition, claims 3-25, 27-29, 31-47, 52, 55-58, and 60-61, which all depend upon one of the independent claims, respectively, recite additional features that are neither disclosed nor suggested by each of the applied references, taken either alone or in combination. Since each of

the dependent claims not only include the same limitations as the respective independent claims, but also recite these additional limitations, they are allowable for at least the same reasons discussed above with respect to the independent claims.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of all the pending claims 2-47, 51-52, 54-58, and 60-61.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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